

## REMARKS

This application has been reviewed in light of the Office Action dated May 27, 2009. Claims 4-7 are presented for examination, of which Claims 4 and 5 are in independent form. Claims 4 and 5 have been amended to define Applicants' invention still more clearly. Favorable reconsideration is requested.

Claims 4-7 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have carefully reviewed and amended Claims 4-7, as deemed necessary, to ensure that they conform fully to the requirements of Section 101 with special attention to the points raised in section 5 of the Office Action. It is believed that the rejection under Section 101 has been obviated, and its withdrawal is therefore respectfully requested.

Claims 4-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for omitting essential steps. Applicants have amended Claim 4 to indicate that the "submitting" recitation is performed by a merchant. With regard to the Office Action's remaining comments in Sections 7 and 8 of the Office Action, Applicants respectfully submit that specific entity and/or entities which perform the features identified in those portions of Office Action are not essential to the claimed invention, nor does the specification indicate that they are. Accordingly, Applicants respectfully request withdrawal of the Section 112, second paragraph, rejection.

The Office Action rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,163,771 (*Walker*), in view of U.S. Patent No. 6,738,749 (*Chasko*); and rejected Claims 5-7 under § 103(a) as being unpatentable over *Walker*, in view of *Chasko*, and further in view of U.S. Patent No. 5,826,241 (*Stein*). Applicants respectfully

traverse these rejections and submit that independent Claims 4 and 5, together with the claims dependent therefrom, are patentably distinct from the cited art for at least the following reasons.

Independent Claim 1 recites, in part,

“receiving, by a merchant . . . , an account number of a user;

submitting, by the merchant . . . , the account number to a provider of the account number and requesting authorization of the transaction;

requesting, by the merchant . . . , that the provider return a secondary transaction number (STN) in lieu of returning the account number;

. . .

maintaining, by the merchant . . . , a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number.”

(Emphasis added).

As discussed in paragraph 94 of the specification, by virtue of these features, the merchant itself can limit its exposure to credit card fraud regardless of the credit card number initially received from a customer for a transaction.<sup>1</sup> Particularly, in traditional transaction processes, upon completing a transaction, the merchant stores transaction information (including the customer’s credit card number) in a merchant database. This database of information is subject to credit card fraud in that a thief could hack into the merchant’s computers to steal its customer’s credit card number. To limit exposure, the merchant may desire to replace those customer credit card numbers with a secondary transaction number (STN), for instance.

Applicants respectfully point out that at the very least the Office must address the fact that it is the merchant itself that takes part in, and is aware of, the secondary transaction

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<sup>1</sup> This discussion is merely for purposes of illustration, and the claimed subject matter is not to be construed as being limited by these examples.

number features of the present invention. Because, as discussed further below, the Office Action has failed to address this subject matter, the rejection is deficient for this reason alone.

The Office Action concedes that *Walker* does not request a secondary transaction number in lieu of returning the account of a user, and that *Walker* does not “teach maintaining, by the merchant, a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number.” Office Action, page 4. The Office Action then apparently looks to *Chasko* to account for these deficiencies. On pages 4 and 5, the Office Action states:

Chasko teaches maintaining, by the merchant, a record of the transaction. (See Figure 6)

The claim is rejected under 35 USC 103 as obvious over Walker in view of Chasko.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Chasko the ability to record the STN. Further a simple substitution of the merchant requesting the STN in Walker would result in the applicants claim. It is within the capabilities of one of ordinary skill in the art to modify both inventions to perform the above mentioned steps.

(Emphasis added).

The portion of *Chasko* relied upon by the Office is seen to offer nothing more than the general concept of recording a transaction data record. In view of this general concept, the Office Action reaches the conclusion that “a simple substitution of the merchant requesting the STN in Walker would result in the applicants claim,” and that “[i]t is within the capabilities of one of ordinary skill in the art to modify both inventions to perform the above mentioned steps.” Applicants respectfully submit that these mere conclusory statements fail to establish a *prima facie* case of obviousness against Claim 1.

It is well established that the Office bears the burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. If the Office does not produce a *prima facie* case of obviousness, then the Appellant is under no obligation to submit evidence of nonobviousness. *Id.* While Applicants acknowledge that the proposed combination must be considered as a whole, Applicants also respectfully submit that a piecemeal analysis of each recitation in the claim without considering the breadth of the claim as a whole is improper. *See* MPEP § 2106 II C (“Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation.”).

As best understood by Applicants, nothing in *Walker*, nor the secondary reference of *Chasko* relied upon by the Office, is seen to address, teach, or reasonably suggest a merchant having any knowledge at all of a secondary transaction number, let alone a merchant taking part in the specific secondary transaction number features, as set forth in Claim 1.

Indeed, the merchant in *Walker* utilizes the same account number provided by the customer for all transaction processing steps, and is unaware of whether the customer provided “a single-use credit card number”. Moreover, even if, *assuming arguendo*, the portions of *Walker* and *Chasko* relied upon by the Office are deemed to suggest the general concepts of secondary transaction numbers and storing transactions as asserted by the Office, they still lack any teaching or reasonable suggestion which even alludes to the merchant specific functionality set forth in Claim 1.

A review of *Stein* has also failed to reveal anything that, in Applicants’ opinion, would remedy the above mentioned deficiencies of *Walker* and *Chasko* as applied against the claims herein.

For at least these reasons, Applicants submit that the Office has not, and can not, sufficiently establish a *prima facie* case of obviousness against amended Claim 4 in view of *Walker*, *Chasko*, and *Stein*, and that the claim is clearly patentable over that cited art, whether considered separately or in combination. Accordingly, the rejection of Claim 4 is deemed obviated, and its withdrawal is respectfully requested.

If the Office does not agree to withdraw the rejection of Claim 4, Applicants respectfully request the Office to explain in detail, with a supporting rationale, specifically which element(s) of *Walker* and/or *Chasko* the Office believes teaches or reasonably suggests the merchant specific features of:

1) the merchant receiving a user's account number to process a transaction and requesting a secondary transaction number from the account number provider; and

2) the merchant replacing the account number with the STN and storing a record of the transaction that does not include the account number.

Independent Claim 5 recites features that are similar in many relevant respects to one or more of the features of Claim 4 emphasized above, and also is believed to be patentable over the above references for the same corresponding reasons given above with respect to those corresponding features.

The other rejected claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable over those references for at least the same reasons as are those independent claims. Because each dependent claim also is deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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